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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,669	02/09/2004	Donald Starr	STA-2.001	1474
22874	7590	08/08/2008	EXAMINER	
GANZ LAW, P.C. P O BOX 2200 HILLSBORO, OR 97123			KIM, CHRISTOPHER S	
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			3752	
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			08/08/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,669

**Applicant(s)**

STARR, DONALD

**Examiner**

Christopher S. Kim

**Art Unit**

3752

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 19-31, 33-36 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 19-28, 41 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31, 33-36, 39, 40 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The response filed June 5, 2008 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Applicant elected with traverse of Group IV, Species A in the reply filed on February 5, 2008.

The requirement was made FINAL in the Office action mailed on March 24, 2008.

4. Claims 1-28, 41 and 42 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 5, 2008.

### ***Claim Objections***

5. Claims 30, 31, 33 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 30 and 31 further limit the tire assembly which is not a positively recited limitation in parent claim 29. Claim 29 recites the "tire assembly" as an intended use of the "at least one support frame."

Claims 33 and 34 further limit the "adjustable connection" which is not a positively recited limitation in parent claim 29. Claim 29 recites the "support frame is capable of providing an adjustable connection..." Claim 29 merely requires that the support frame be capable of providing the adjustable connection. For example, if the support frame has a mounting point that is capable of mounting an adjustable connection, it is capable of providing an adjustable connection. The adjustable connection is not a positively recited limitation.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for each tower connecting to a wheel assembly (a plurality of towers where one tower has one wheel assembly), does not reasonably provide enablement for a plurality of towers connected to a wheel assembly (a plurality of towers all connected to the same wheel assembly). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claim allows for both interpretations: plurality of towers, each tower connected to its own wheel assembly; or plurality of towers, each tower connected to the same single wheel assembly. Similarly, the claim also recites, "each member being coupled to a vertical member at opposite sides of an axle for the tire assembly.."

8. Claims 29-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 29, the preamble is directed to a wheel assembly but further recites that the wheel assembly is connected to a tower. The claim is directed to the subcombination of a wheel assembly but further makes reference to the combination of a wheel assembly and a mobile irrigation system.

Claim 29 recites "a wheel assembly" in line 3. It appears to be a double inclusion of the "wheel assembly" recited in line 1.

Claim 29 is directed "a wheel assembly" but contains limitations directed to the axle. See lines 15-16.

Claim 33 further defines the adjustable connection in relation to the tower and tire assembly which are not positively recited limitations as indicated by claim 29.

Claim 35 recites "a swivel support tube that is telescopically coupled to the tower." The preamble is directed to the subcombination of a wheel assembly but the body of the claim includes a limitation directed to the combination of the wheel assembly and the tower.

Claim 36 recites, "a first support member...a second support member" in lines 3-4. They appear to be a double inclusion of the "assembly of a first horizontal member and a second horizontal member" and/or the "vertical member" recited in claim 29.

The preamble of claim 36 is directed to the subcombination of a wheel assembly but the body of the claim contains a recitation directed to the combination of a wheel assembly, tower and tire assembly, e.g., "such that the weight of the tower is distributed substantially equally across the opposite sides of the tire assembly."

Claims 39 and 40 further defines the force transfer member in relation to the tower and tire assembly which are not positively recited limitations as indicated by claim 29. The preamble of claims 39 and 40 is directed to a wheel assembly but the body of the claims contain recitations directed to the combination of a wheel assembly and tower.

Claim 43 recites "a tire assembly" in line 6. It appears to be a double inclusion of the "tire assembly" recited in line 4.

Claim 43 recites "a tower" in line 9. It appears to be a double inclusion of the "tower" recited in line 3.

Claim 43 recites "a tower" in line 9. It is uncertain which of the plurality of towers it is referencing.

Claim 43 requires a plurality of towers and each tower connecting to a wheel assembly, i.e., claim 43 requires a plurality of wheel assemblies, but the claim only requires one tire assembly. When claim 43 recites functional language directed to the tire assembly, e.g., "for supporting a tire assembly...capable of providing and adjustable

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connection between the tower and the tire assembly...positionable over a tire assembly," it is uncertain whether the tire assembly is in relation to the tire assembly recited in line 4.

Claim 43 recites "the support frame" in line 9. It is uncertain which support frame it is referencing. Claim 43 requires a plurality of wheel assemblies because each tower is connected to a wheel assembly.

Claim 43 recites "the wheel assembly" in line 10. It is uncertain which wheel assembly it is referencing.

Claim 43 recites "a tire assembly" in line 14. It appears to be a double inclusion of the "tire assembly" recited in line 4.

Claim 43 recites the limitation "tire assemblies" in line 16. There is insufficient antecedent basis for this limitation in the claim.

The claims are replete with indefiniteness. Applicant is required to ensure that all of the claims in their entirety comply with 35 U.S.C. 112, second paragraph.

It is noted that while not indefinite, the claims are replete with language that merely requires capability to perform, e.g., configured to, capable of, positionable, adjustable, may be. Such recitations are not positively recited limitations and have been considered to merely require the ability to perform.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 29-31, 34-36, 39, 40 and 43 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Astle (738,271).

Astle discloses a wheel assembly comprising:

at least one support frame 28, 21, 22.

In the preamble, "for a mobile irrigation system having an elongated boom and a plurality of downwardly extend towers, each connecting to a wheel assembly" indicates intended use and is not a positively recited limitation.

In the body, "for supporting a tire assembly on opposite sides so as to distribute weight from the tower across the opposites sides of the tires assembly" indicates intended use and is not a positively recited limitation.

In the body, "adapted to be coupled to a tower" merely requires the capability to be coupled to a tower and is not a positively recited limitation.

Claims 30 and 31 further define the tire assembly which is not a positively recited limitation as indicated by claim 29.

Regarding claims 32, 34 and 35, the support frame 28, 21, 22 provides for an adjustable connection 24.

Regarding claims 39 and 40, Astle further discloses a force transfer member 20.

11. Claims 29-31, 36, 39, 40 and 43 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Chapman (6,131,833).

Chapman discloses a wheel assembly comprising:



at least one support frame 32, 34, 38, 40.

In the preamble, "for a mobile irrigation system having an elongated boom and a plurality of downwardly extend towers, each connecting to a wheel assembly" indicates intended use and is not a positively recited limitation.

In the body, "for supporting a tire assembly on opposite sides so as to distribute weight from the tower across the opposites sides of the tires assembly" indicates intended use and is not a positively recited limitation.

In the body, "adapted to be coupled to a tower" merely requires the capability to be coupled to a tower and is not a positively recited limitation.

Claims 30 and 31 further define the tire assembly which is not a positively recited limitation as indicated by claim 29.

Regarding claim 32, the support frame 32, 34, 38, 40 provides for an adjustable connection 42.

Regarding claims 39 and 40, Chapman further discloses a force transfer member 42.

### ***Response to Arguments***

12. Applicant's arguments filed June 5, 2008 have been fully considered but they are not persuasive.

The claims are replete with language that merely requires capability to perform, e.g., configured to, capable of, positionable, adjustable, may be. Such recitations are

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not positively recited limitations and have been considered to merely require the ability to perform.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher S. Kim/  
Primary Examiner, Art Unit 3752

CK